BEFORE THE

Supreme Court of the United States

OCTOBER TERM, 1944.

Nos 738

MINNESOTA MINING & MANUFACTURING COMPANY, *Petitioner,*

v.

CONWAY P. COE, COMMISSIONER OF PATENTS, *Respondent.*

PETITION FOR WRITS OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA AND BRIEF IN SUPPORT THEREOF.

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PRESS OF BYRON S. ADAMS, WASHINGTON, D. C.

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PETITION FOR WRITS OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA.

To the Honorable, the Chief Justice and Associate Justices of the Supreme Court of the United States:

Your petitioner, Minnesota Mining & Manufacturing Company, by its undersigned attorneys, respectfully prays that writs of certiorari issue to the United States Court of Appeals for the District of Columbia to review the judgments of that court entered on July 10, 1944, affirming the dismissal of petitioner's bills of complaint in the above two closely related cases. (Said causes were consolidated for purposes of trial and for argument on appeal, and were decided in a single opinion, R. 417-19.) A petition for rehearing (R. 421) was filed within the time limit and was denied by the court on September 8, 1944 (R. 426). The transcript of the record, including the proceedings in the

said United States Court of Appeals for the District of Columbia, is furnished herewith in accordance with Rule 38 of this Court.

Short and Summary Statement of the Matter Involved.

On December 1, 1933, Clifford L. Jewett, petitioner's assignor, filed an application for a patent in the United States Patent Office, Serial No. 700,632. The invention of the application concerns roofing granules having a very thin, weather-resistant colored coating firmly bonded to the surface of mineral base granules, so that the granules will maintain their color for long periods of time upon exposure to the atmosphere and will be free or substantially free of blooming, *i. e.*, unsightly white efflorescent salts.

The Examiner in the Patent Office rejected applicant's claims and his rejection was affirmed by the Board of Appeals, whereupon petitioner filed a complaint in the United States District Court for the District of Columbia under the provisions of Section 4915 of the Revised Statutes, U. S. C., Title 35, Section 63 (Appendix, pp. 37, 38), which action was given Equity No. 64,920. The district Court rendered a decision favorable to petitioner (see *Minnesota Mining & Mfg. Co.* vs. *Coe,* 28 F. Supp. 80 D. C., Dist. Col., 1939) and also made findings of fact and conclusions of law favorable to petitioner in that action on June 19, 1939 (R. 170-176).

In the meantime, namely, on January 3, 1939, the Commissioner of Patents granted to one Marion H. Veazey, on application filed later than Jewett, a patent, claims 8 and 9 of which are broader than, and fully dominate the claims which had been held patentable to Jewett by the district court.

When the Jewett application was returned to the Patent Office, following an allowance of the claims held patentable by the court, a petition for renewal was filed in accordance with settled law and practice and claims 8 and 9 of said

Veazey patent were asserted as claims 71 and 72 of said Jewett application (R. 25). The Examiner in the Patent Office finally rejected these claims, and also other claims in the application, except those which the court had held patentable, and his rejection was affirmed by the Board of Appeals of the United States Patent Office. The two claims of the aforesaid Jewett application S. N. 700,632 which correspond verbatim with claims 8 and 9 of the Veazey patent (R. 197), and which are numbered 71 and 72 (R. 25), as well as several other claims, were considered by the district court in Civil Action No. 13,832, timely brought under the provision of Section 4915 R. S., from which Appeal No. 8454 was timely taken and prosecuted. The district court's judgment was adverse to the petitioner (R. 159); and the affirming decision of the court of appeals (R. 417-419) was also unfavorable.

A related Jewett application S. N. 305,294, based largely on the earlier application S. N. 700,632, aforesaid, was filed in the Patent Office on November 20, 1939 and, following final rejection and appeal to the Board of Appeals, a complaint was filed under Section 4915 R. S., the cause being given Civil Action No. 8420, in respect to which an adverse judgment was rendered by the district court (R. 16) on the same day as in Civil Action No. 13,832, aforesaid. Civil Action No. 8420 came before the court of appeals as Appeal No. 8453, wherein the decision of the district court was affirmed in the aforementioned opinion (R. 417-19).

Questions Presented.

The decision of the Court of Appeals for the District of Columbia raises the following questions of law:

Question 1.

Does Section 4915 R. S. (U. S. C., Title 35, Section 63) convey jurisdiction upon the District Court for the District of Columbia of an action begun by bill in equity by an appli-

cant who has been refused a patent by the Board of Appeals, where, if the court holds for the applicant, further prosecution in the Patent Office may take place in "complying with the requirements of law"? (see R. S. 4915 at Appendix, pp. 37, 38).

Question 2.

In Section 4915 R. S. (U. S. C., Title 35, Section 63), which provides "Whenever a patent on application is refused by the Board of Appeals or whenever any applicant is dissatisfied with the decision of the board of interference examiners, the applicant . . . may have remedy by bill in equity . . .", does the word "or" mean "and", whereby action by both boards must precede applicant's right to the remedy provided?

Question 3.

In an action brought by an applicant for a patent under Section 4915 R. S. (U. S. C., Title 35, Section 63) against the Commissioner of Patents as defendant, and following a refusal by the Board of Appeals to grant the patent, is a third party claiming the same invention a necessary party when not involved in interference with the applicant to determine priority of invention but where an interference may be set up by the Patent Office if the court holds for the applicant?

Question 4.

Can the Court of Appeals for the District of Columbia, in an action brought by an applicant under Section 4915 R. S. involving claims copied from the patent of another granted on a later filed application, refuse to rule on the question of support for said claims in the application in issue, when the Patent Office has held the claims to be patentable and the question of support in appellant's application is the only issue directly raised by the appeal?

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Questions 1, 2 and 3 are presented in precisely the same form as they were presented in *The Hoover Company* vs. *Coe,* Petition No. 486, in which a writ of certiorari was granted by this Court on November 6, 1944. The court of appeals decided *the Hoover case* on the same day as these cases, *viz.* July 10, 1944.

Reasons Relied Upon for the Allowance of the Writs of Certiorari.

The discretionary power of the Court is invoked upon the following grounds:

1. **The main questions of law presented are precisely the same as those presented in The Hoover Company vs. Coe, Petition No. 486, in which this Court granted a writ of certiorari on November 6, 1944.**

The decision of the United States Court of Appeals for the District of Columbia (R. 417-19) was held up for a longer period than usual, and the court's decision herein was rendered on July 10, 1944, *i. e.* on the same day as the court's decision in *The Hoover Company* vs. *Coe,* which latter was decided after the court had set it for reargument on substantially the questions presented as 1, 2 and 3, hereinabove. The *Hoover Company* decision is cited in the footnote to the court of appeals' decision in the present case (R. 418). The facts here presented are on all fours with the facts of the *Hoover* case; this is indicated by the petition of the Hoover Company.* The decision of the

*At pages 25 and 26 of the Hoover Company's brief in support of their petition, it is stated:

"... because of the facts in the *Minnesota Mining Co.* case which it specified and which are on all fours with the facts in the instant case. In the instant case, as in the *Minnesota Mining Co.* case 'a few' (one) of the claims were copied from an application (the Bergholm patent) ... which was filed ... later than the original Hoover application ... In the Hoover case, as in the Minnesota case, 'it may be' that 'the record contains enough evidence to

Supreme Court in the *Hoover Company* case, if favorable to that petitioner, will show that the judgment of the court of appeals in the instant causes was erroneous.

It is believed that the present causes, in respect to the questions here presented, could properly be set for argument concurrently with *The Hoover Company* vs. *Coe*.

2. The questions of law presented depend upon the construction of a United States statute and are of great public importance.

The United States Court of Appeals for the District of Columbia, in denying the jurisdiction of the district court, has raised several questions of general importance relating to the construction of a statute of the United States *i. e.* Revised Statute, Section 4915, as amended by Act of August 5, 1939 (Appendix, pp. 37, 38). That statute provides for an action by bill in equity whenever a patent is refused by the Board of Appeals of the Patent Office.

The questions potentially affect the right of every applicant for a patent to the relief provided by law from an unjust refusal of a patent in the Patent Office. The facts of the present case are on all fours with the facts presented in *The Hoover Company* vs. *Coe* (144 F. (2d) 514, Ct. App. D. C., July 10, 1944) decided the same day by the same court. The mention of a *possibility* of a difference, given in the footnote to the court's decision (R. 418), resulted from the court's statement, "It is *not clear*",* *etc.* Actually there is no distinction.

The Rules of Practice in the United States Patent Office are inconsistent with the requirements of the lower court and make impossible the prerequisite to its jurisdiction

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show that the plaintiff (Hoover) was prior in time without the necessity of further interference proceedings.' In the Hoover case as in the Minnesota case 'the appeal (a 4915 action in each case) involves a number of similar claims which were not copied.' "

*Italics supplied throughout unless otherwise noted.

which it demands. The statutory duty placed upon the Commissioner of Patents in Section 4904 R. S. also makes it impossible for the required prerequisite to be present.

3. The questions of law presented have not been, but should be, decided by this Court.

The questions of law presented have not been considered by this Court but the decision of the Court of Appeals for the District of Columbia represents a departure from established practice as set forth by that court in *Pitman* v. *Coe* (68 F. (2d) 412, Ct. App. D. C., 1933). For the first time an applicant for a patent is denied the relief provided by Section 4915, R. S., because of what the Patent Office may subsequently do, should the applicant prove himself entitled to a favorable decision. The decision is inconsistent with this Court's views as expressed in *Gandy* v. *Marble* (122 U. S. 432, 1887). The decision is in direct conflict with the same court's decision upon the question of jurisdiction in *Thorne, Neale & Co.* v. *Coe*, (143 F. (2d) 155, Ct. App. D. C., June 19, 1944) decided after the present cases were argued and a few weeks prior to the decision in the present cases.

As the Commissioner of Patents has his official residence in the District of Columbia, and as today all suits of an *ex parte* nature in which he is named as the sole party defendant are necessarily brought in the District of Columbia, it is entirely unlikely that these questions will be raised in cases arising in other jurisdictions (*Butterworth* v. *Hill*, 114 U. S. 128, 1885). However, under a discarded practice in which in such cases the Commissioner of Patents accepted service in jurisdictions other than the District of Columbia, the Circuit Court of Appeals for the Second Circuit in *Gold* v. *Newton* (254 F. 824, CCA2, 1918) followed a contrary practice, the question of jurisdiction being in issue.

The law announced in *Hoover* v. *Coe* and in the concurrent decision in the instant cases has been cited as controlling by

the Court of Appeals for the District of Columbia in other cases, *viz.*, *Line Material Co.* v. *Coe*, (62 USPQ 120, Ct. App. D. C., July 10, 1944) and *The Colgate-Palmolive-Peet Co.* v. *Coe* (62 USPQ 121, Ct. App. D. C., July 10, 1944).

4. The court of appeals has not given proper effect to applicable decisions of this Court.

The court below denied that a suit under Section 4915 R. S. (Appendix, pp. 37-38) was a proper method of reviewing an administrative ruling in a case where plaintiff's right to a patent cannot be determined, free of the possibility of a subsequent interference in the Patent Office.

This Court in *Steinmetz* v. *Allen* (192 U. S. 543, 1904) held that the requirement of "division" made by the Examiner without action upon all the merits of Steinmetz's case was "final and appealable".

This Court in *Frasch* v. *Moore* (211 U. S. 1, 1908) recognized the right of an applicant to bring a bill in equity under Section 4915 R. S. where the refusal of the patent was based upon a requirement for division with which the applicant refused to comply.

5. The judgment and opinion of the court of appeals in the Hoover case and in the present case may seriously hinder and confuse the future administration of the law by the Patent Office, particularly with respect to Revised Statute 4904.

This reason is believed alone to be adequate to support the granting of the petition (*Federal Trade Commission* v. *American Tobacco Co.*, 274 U. S. 543, 1927).

Section 4904, Revised Statutes, as amended by Act of August 5, 1939 (Appendix, p. 36), provides that the Commissioner of Patents shall direct the setting up of an interference "Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere

with any pending application, or with any unexpired patent to determine the question of priority of invention." The setting up of the interference is, as noted, made dependent upon the "opinion of the Commissioner" and is not mandatory.

In conformance with Section 4904 R. S. (Appendix, p. 36), Rule 94 of the Patent Office (Appendix, pp. 40, 41) provides for interferences when the claims which recite the common invention "are allowable in the application of each party," or, when a patent and an application are involved, when the claims "are allowable in all of the applications involved".

The decision of the court of appeals requires, in order for an applicant for a patent to be entitled to the relief provided by Revised Statutes, Section 4915 (Appendix, pp. 37, 38), that the Commissioner set up an interference even though he is of the opinion that the claimed subject matter is not allowable in all the applications.

If the Commissioner is not to deprive applicants for patents of their rights as provided by Revised Statutes, Section 4915, then he must, under the decision of the court below, set up interferences when in his opinion none properly should be contested. The function is administrative and properly lies entirely within the Commissioner's discretion.

WHEREFORE your petitioner respectfully prays that writs of certiorari be issued out of and under the seal of this Court directed to the United States Court of Appeals for the District of Columbia, commanding the said court to certify and send to this Court on a day designated a full and complete transcript of the record and all proceedings in the court of appeals had in these consolidated causes, to the end that the same may be reviewed and determined by this Court; that the judgments of the said court of appeals

be reversed; and that said petitioner be granted such other and further relief as may be deemed proper.

MINNESOTA MINING & MANUFACTURING COMPANY,
Petitioner.

By HAROLD J. KINNEY,
Attorney for Petitioner.

CHAS. S. GRINDLE,
Of Counsel.

I hereby certify that I have read the foregoing petition for certiorari, and that in my opinion it is well founded and presents grounds whereon the prayer ought to be granted, and I further certify that it is not intended for purposes of delay.

HAROLD J. KINNEY,
Attorney for Petitioner.